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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/306,448 05/06/99 WILLIAMSON

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EXAMINER

QM12/0928

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PRELIMINARY

ART UNIT

PAPER NUMBER

3738

20

DATE MAILED:

09/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/306,448**

Applicant(s)  
**Williamson IV et al**

Examiner  
**Paul Prebilio**

Art Unit  
**3738**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 21, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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***Continued Prosecution Application***

The request filed on July 25, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/306,448 is acceptable and a CPA has been established. An action on the CPA follows.

After reviewing the 37 CFR 1.132 declarations filed December 21, 2000, it was determined that they were not sufficient to overcome the Williamson, IV et al (US Patent 6,042,607) because the declarations were only from the uncommon inventors and not the common inventors; see MPEP 716.01. For this reason, the rejections utilizing this patent have been reinstated below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 16-18, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Williamson, IV et al (US 6,042,607) wherein the staple fasteners of Williamson, IV et al are deformed through the sewing ring and tissue to attach the tissue to the sewing ring; see the whole document, especially column 22, line 52 to column 24, line 18.

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With regard to claims 17, 24, and 25 specifically, it is noted that the tips of the staples of Williamson are rotated about the center portion such that the claimed rotational motion is met thereby.

Claims 16-18, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Williamson, IV et al (US 5,716,370) wherein the staple fasteners of Williamson, IV et al are deformed through the sewing ring and tissue to attach the tissue to the sewing ring; see the whole document, especially Figures 4 and 12-14 as well as column 13, lines 12-40.

With regard to claims 17, 24, and 25 specifically, it is noted that the tips of the staples of Williamson are rotated about the center portion such that the claimed rotational motion is met thereby.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 19-22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, IV et al (US 6,042,607) in view of Bachinski et al (US 6,036,702). Williamson IV et al meet the claim language as explained in the Section 102 rejection, but lacks the fasteners which are only elastically deformed as claimed. Bachinski et al teach, however, that non-

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deforming fasteners have been known to the art; see the whole document wherein prongs (522) constitute non-deforming fasteners. Moreover, Williamson, IV et al teaches that sutures, which are also not plastically deformed in use, have been known in the art as means to attach tissue and implants together. Hence, it is the Examiner's position that it would have been obvious to use either of these non-deforming fasteners in addition to the fasteners of Williamson IV et al in order to more securely and sealingly attach the valve, sewing ring and tissue together.

Claims 1-15, 19-22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, IV et al (US 5,716,370) in view of Bachinski et al (US 6,036,702). Williamson IV et al meet the claim language as explained in the Section 102 rejection, but lacks the fasteners which are only elastically deformed as claimed. Bachinski et al teach, however, that non-deforming fasteners have been known to the art; see the whole document wherein prongs (522) constitute non-deforming fasteners. Moreover, Williamson, IV et al teaches that sutures, which are also not plastically deformed in use, have been known in the art as means to attach tissue and implants together. Hence, it is the Examiner's position that it would have been obvious to use either of these non-deforming fasteners in addition to the fasteners of Williamson IV et al in order to more securely and sealingly attach the valve, sewing ring and tissue together.

### ***Response to Arguments***

Applicant's arguments filed July 25, 2001 and August 21, 2001 have been fully considered but they are not persuasive.

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In particular, Applicants filed recorded assignment data which as intended to show common ownership. However, Serial No. 08/606,343 now US Patent 5,716,370 had an assignment to Cardiovascular Technologies LLC on the day that the present invention was made May 6, 1999 (on July 25, 2001 as well). In addition, Serial No. 08/802,948 now US Patent 6,042,607 had also had an assignment to Cardiovascular Technologies LLC on May 6, 1999 (on July 25, 2001 as well). However, the present application had no assignment on the day of its invention May 6, 1999 (on July 25, 2001). For this reason, there is no showing of common ownership as required to overcome the rejections under 35 USC 103(a).

In addition, it is pointed out that a separate paper which clearly and conspicuously states that common ownership existed is required to show common ownership; see MPEP 706.02(l)(2) 8th edition. However, in the present case, the Examiner has reviewed the assignment data and determined that there was not common ownership at the time the present invention was made. In addition, it is noted that *"the requirement for common ownership at the time the claimed invention was made is intended to preclude obtaining ownership of subject matter after the claimed invention was made in order to disqualify the subject matter as prior art against the claimed invention."* (MPEP 706.02(l)(2) page 700-37 third full paragraph on right column of 8th edition) For this reason, the Examiner does not see how Applicants can overcome these rejections by this route. Declarations under 37 CFR 1.132 may be the only route left, but this is applicable against the Section 103 rejections.

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*Conclusion*

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
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